

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

----- X  
REPUBLIC RESTAURANT, INC., :

Plaintiff, :

vs. :

Case No. 03-CV-12649-MLW

HAYDAN WASHINGTON STREET, INC., :  
d/b/a PHO REPUBLIQUE and JACK H. :  
BARDY, :

Defendants. :

----- X

**DECLARATION OF JEFFREY M. TAMARIN IN OPPOSITION TO DEFENDANT'S  
CROSS MOTION FOR A DISMISSAL UPON CONDITIONS AND IN FURTHER  
SUPPORT OF PLAINTIFF'S RULE 41 MOTION TO DISMISS WITHOUT PREJUDICE**

Jeffrey M. Tamarin declares as follows under penalty of perjury:

1. I am a partner in the law firm of Reed Smith LLP and am admitted *pro hac vice* in this action as co-counsel for Plaintiff, Republic Restaurant, Inc. ("Republic"). I make this declaration in opposition to Defendant's Cross-Motion for a Dismissal Upon Conditions and in further support of Republic's Motion to Dismiss the Action Without Prejudice, pursuant to Rule 41(a)(2) of the Federal Rules of Civil Procedure.

2. Defendant bases its cross-motion upon a complete mischaracterization of plaintiff's efforts to police its REPUBLIC trademark. Defendant attempts to paint plaintiff as engaging in essentially bad faith litigation, not only in the instant action but also in its dealings with the owner of a restaurant in Texas that has been using the name PHO REPUBLIC for yet another restaurant offering Vietnamese cuisine, including pho (i.e., Vietnamese noodle soup). The name and mark, PHO REPUBLIC, like defendant's name and mark, PHO REPUBLIQUE, used in connection with a restaurant offering Vietnamese cuisine, including pho, is confusingly

similar to plaintiff's REPUBLIC name and mark and would be likely to cause confusion, but for the current geographic remoteness of the various restaurants operating under the REPUBLIC mark – as explained in plaintiff's underlying Rule 41 Motion to Dismiss Without Prejudice.

3. Contrary to misstatements and mischaracterizations in defendant's cross-motion, the dispute between plaintiff Republic and the owner of the restaurant in Texas and how that dispute has played out is quite different from what has occurred in the instant action.

4. Central to the dispute in Texas was the fact that the defendant there, Noodle-O-1, Inc. ("Noodle-O-1"), had obtained a registration for the mark PHO REPUBLIC, due to an error by the trademark examiner, who processed the application at the U.S. Patent and Trademark Office ("PTO") without realizing that Republic had a prior registration for the REPUBLIC mark. A printout of a page from the PTO's Trademark Electronic Search System annexed hereto as Exhibit A shows that the PHO REPUBLIC mark was registered on January 28, 2003 (and also that "The English translation of "PHO" is "soup"). Republic's attorneys sent letters to N Noodle-O-1 demanding withdrawal of the registration, but the letters went unanswered. Republic then brought a cancellation proceeding at the Trademark Trial and Appeal Board, seeking cancellation of Noodle-O-1's registration.

5. In March 2003, Republic filed a Petition for Cancellation with the Trademark Trial and Appeal Board (the "TTAB"), seeking to cancel the registration of Noodle-O-1's mark. After Noodle-O-1 failed to respond to the Petition for Cancellation, The TTAB mailed a Notice of Default to Noodle-O-1 on December 9, 2003. Noodle-O-1 again failed to respond. On May 29, 2004, the TTAB entered judgment by default against Noodle-O-1 and granted the Petition to Cancel Noodle-O-1's Registration. On July 15, 2004, the registration was canceled. *See* copy of page from TTAB web site, annexed hereto as Exhibit B.

6. Republic's counsel again wrote to Noodle-O-1 demanding that it cease its use of the PHO REPUBLIC mark. After still receiving no response, Republic brought suit in the Northern District of Texas. As explained in Republic's underlying Rule 41 Motion in this action, at that time Republic had been planning a geographic expansion of its restaurants. Noodle-O-1 then filed an answer to the Complaint in the Northern District of Texas. In addition, Noodle-O-1 filed with the TTAB a motion for relief from the default judgment and a petition to reinstate the registration.

7. Republic opposed the vacating of the default and reinstatement of the registration; however, the TTAB lifted the default and reinstated the registration, thereby permitting Republic's Petition to Cancel the PHO REPUBLIC registration to proceed on the merits. In March 2005, Noodle-O-1 filed its Answer to the Petition to Cancel at the TTAB.

8. While the default motions at the TTAB had been pending, the parties did little in connection with the action pending in the Northern District of Texas other than engage in various attempts to negotiate a settlement. On March 31, 2005, the parties engaged in mediation in an effort to resolve the dispute entirely. Instead, they ended up agreeing to stipulate to dismissal of the action in Texas without prejudice and to argue their cause to the TTAB and to allow the TTAB to make a determination regarding cancellation of Noodle-O-1's PHO REPUBLIC mark. A copy of the Stipulated Order of Dismissal Without Prejudice in the Northern District of Texas action is annexed hereto as Exhibit C.

9. Ultimately, the TTAB proceedings will likely influence the timing and scope of any geographic expansion by Republic. Meanwhile, Republic has no imminent plans to open a restaurant in the Boston area.

10. Accordingly, as explained at the June 24, 2005 status conference in this action and in Republic's underlying Rule 41 Motion, Republic has come to believe that it may be extremely difficult or impossible for it to prove *present*, likelihood of confusion, given the current geographic remoteness of the two restaurants operating under the REPUBLIC mark. Such demonstrable likelihood of confusion is likely to exist only when and if plaintiff Republic should ever open a REPUBLIC restaurant in or near Boston or otherwise sufficiently expand geographically so that such likelihood of confusion would exist.

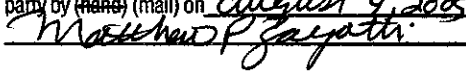
11. Republic has only ever acted in good faith in this action, and continues to act in good faith in seeking a dismissal without prejudice pursuant to Rule 41. Defendant, however, is merely wasting the resources of the parties and this Court in pursuing its cross-motion to impose conditions on the dismissal.

12. Accordingly, plaintiff Republic respectfully requests that defendant's cross-motion be denied and that this Court grant Republic's underlying motion and issue an order dismissing this action without prejudice pursuant to Rule 41(a)(2).

DATED: New York, New York  
August 3, 2005

  
JEFFREY M. TAMARIN

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the above document was served upon the attorney of record for each other party by ~~hand~~ (mail) on August 4, 2005  


**EXHIBIT A**



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#### Typed Drawing

<b>Word Mark</b>	PHO REPUBLIC
<b>Translations</b>	The English translation of "PHO" is "soup".
<b>Goods and Services</b>	IC 042. US 100 101. G & S: RESTAURANT AND TAKE-OUT SERVICES. FIRST USE: 20010415. FIRST USE IN COMMERCE: 20010706
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	78073502
<b>Filing Date</b>	July 12, 2001
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	June 25, 2002
<b>Registration Number</b>	2681145
<b>Registration Date</b>	January 28, 2003
<b>Owner</b>	(REGISTRANT) Noodle-O-1, Inc. CORPORATION TEXAS 3591 N. Beltline Road Irving TEXAS 75062
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PHO" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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**EXHIBIT B**





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## TTABVue. Trademark Trial and Appeal Board Inquiry System

### Cancellation

**Number:** 92041815

**Filing Date:** 03/11/2003

**Status:** Pending

**Status Date:** 03/10/2005

**Interlocutory Attorney:** CHERYL S GOODMAN

#### Defendant

**Name:** Noodle-O-1, Inc.

**Correspondence:** Dana C Jewell  
Fulbright & Jaworski LLP  
2200 Ross Avenue, Suite 2800  
Dallas, TX 75201

**Serial #:** 78073502

**Registration #:** 2681145

**Application Status:** Cancellation Pending

**Mark:** PHO REPUBLIC

#### Plaintiff

**Name:** Republic Restaurant Corp.

**Correspondence:** Jeffrey M. Tamarin  
Reed Smith LLP  
599 Lexington Avenue  
New York, NY 10022-7650  
dcohen@reedsmith.com

**Serial #:** 74732568

**Registration #:** 2067872

**Application Status:** Section 8 and 15 - Accepted and Acknowledged

**Mark:** REPUBLIC

#### Prosecution History

#	Date	History Text	Due Date
20	06/13/2005	<u>STIPULATION FOR AN EXTENSION OF TIME</u>	
19	03/01/2005	<u>ANSWER</u>	
18	03/10/2005	<u>CANCELLATION OF REG SET ASIDE</u>	
17	03/10/2005	<u>CANCELLATION OF REG SET ASIDE, REG IN FULL EFFECT OF ORIG REG DATE</u>	
16	02/14/2005	<u>CHANGE OF CORRESPONDENCE ADDRESS</u>	
15	01/28/2005	<u>BOARD'S JUDGMENT SET ASIDE, REG REINSTATED, T.D. RESET</u>	
14	09/20/2004	<u>PL'S REPLY PETITION TO COMM'R</u>	
13	09/20/2004	<u>DEF'S REPLY MOT. TO VACATE</u>	
12	08/27/2004	<u>PL'S OPP. TO DEF'S MOT. TO VACATE</u>	
11	08/11/2004	<u>PETITION TO REINSTATE REGISTRATION</u>	
10	08/11/2004	<u>D'S MOTION FOR RELIEF FROM JUDGMENT</u>	
9	07/15/2004	<u>TERMINATED</u>	
8	07/15/2004	<u>COMM'RS ORDER CANCELLING REGISTRATION</u>	
7	05/29/2004	<u>BOARD'S DECISION: GRANTED</u>	
6	05/11/2004	<u>DELETE ENTRY</u>	

5 12/09/2003 NOTICE OF DEFAULT

4 04/10/2003 Pl's #2 returned undeliverable

3 04/02/2003 PENDING, INSTITUTED

2 04/02/2003 NOTICE AND TRIAL DATES SENT; ANSWER DUE:

05/12/2003

1 03/11/2003 FILED AND FEE

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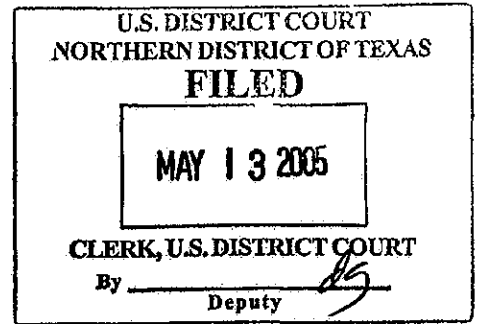
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**EXHIBIT C**

ORIGINAL

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS



REPUBLIC RESTAURANT, INC.,

Plaintiff,

v.

NOODLE-O-1, INC. d/b/a Pho Republic  
Restaurant,

Defendant.

§  
§  
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§

Civil Action No. 3:04-CV-1413-L

**STIPULATED ORDER OF DISMISSAL WITHOUT PREJUDICE**

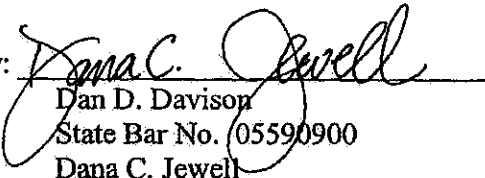
WHEREAS, the parties stipulate to dismiss this matter without prejudice in accordance with the terms set forth below;

NOW THEREFORE, having considered the foregoing, and on consent of the parties, it is hereby ORDERED, as follows:

1. This action is hereby dismissed without prejudice;
2. This dismissal shall not be used by or on behalf of either party in the currently pending cancellation proceeding, Cancellation No. 92041815, before the United States Patent and Trademark Office Trademark Trial and Appeal Board; and
3. The parties shall bear their own attorney's fees and costs with respect to the above referenced action.

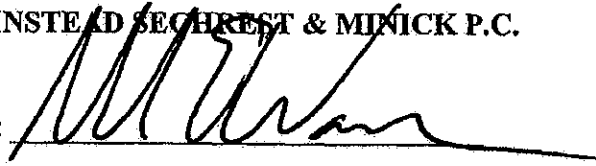
Dated: Dallas, Texas  
May 11, 2005

**FULBRIGHT & JAWORSKI L.L.P.**

By:   
Dan D. Davison  
State Bar No. 05590900  
Dana C. Jewell  
State Bar No. 24027029  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201  
(214) 855-8000

*Attorneys for Defendant Noodle-O-1, Inc.*

**WINSTEAD SECHREST & MINICK P.C.**

By:   
Sanford E. Warren, Jr.  
State Bar No. 20888690  
5400 Renaissance Tower  
1201 Elm Street  
Dallas, Texas 75270-2199  
(214) 745-5400

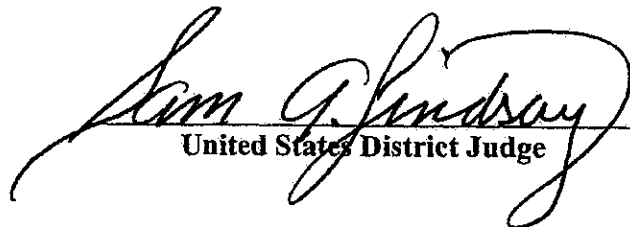
**REED SMITH LLP**

Jeffrey M. Tamarin  
(*pro hac vice*)  
599 Lexington Avenue  
New York, New York 10022  
(212) 521-5400

*Attorneys for Plaintiff  
Republic Restaurant, Inc.*

**IT IS SO ORDERED.**

Dated: May 13, 2005

  
United States District Judge